

Application Serial No. 10/538,426
Reply to Office Action of July 2, 2007.

PATENT
Docket: CU-4247

REMARKS

In the Office Action, dated July 2, 2007, the Examiner states that Claims 1-8 are pending and Claims 1-8 are rejected. By the present Amendment, Applicant amends Claims 4-8 and adds new Claims 9-11. Claims 4-7 are amended to remove the multiple dependencies. Claim 8 is amended to recite a method step.

In the Office Action, Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 11/048,441 in view of Carrick (U.S. Pub. No. 2004/0102335). Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 11/048,573 in view of Carrick. Claims 1-8 are also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 11/523,566 in view of Carrick. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 11/462,340 in view of Carrick.

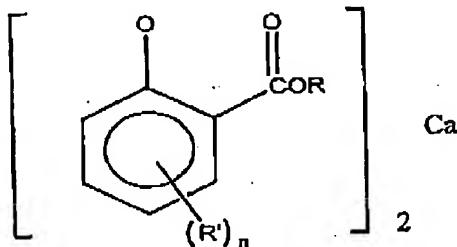
The Applicant has submitted a terminal disclaimer with this response to overcome the double patenting rejections, and therefore, the rejections should be withdrawn.

In the Office Action, Claim 8 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Applicant has amended Claim 8 to recite a method step, and therefore, this rejection should be overcome.

In the Office Action, Claims 1 and 3-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carrick in view of Campbell (U.S. 5,415,792). The Applicant respectfully disagrees with and transverses this rejection. In the present invention, the salicylate which is represented by chemical formula (1) are salts of a carboxyl group of alkyl salicylic acid and alkaline (alkaline earth) metal. In contrast, the salicylates disclosed in Campbell are compounds that are represented by the chemical formula below, where hydroxyl group and alkaline earth metal are bonded.

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Therefore, the salicylate that is claimed in the present invention is different from that disclosed in Campbell.

Specifically, in the salicylate of Campbell, the carboxyl group forms an ester with an alkyl group of from 1 to 6 carbon atoms (column 3, line 31). The ester is referred to as "alkylated alkyl salicylate." Furthermore, Campbell discloses, in column 1, line 67 through column 2, line 8, "alkylated alkyl salicylates can be overbased without hydrolysis of the ester functionality to provide for overbased lubricating oil additives suitable for use in lubricating oil compositions. This discovery is particularly surprising in view of the fact that the overbased products of this invention lack carboxyl (-COOH) functionality but, rather, possess an ester (-COOR) functionality (R being alkyl of from 1 to 6 carbon atoms)." Additionally, Campbell discloses in column 4, lines 62-66, "I believe that the alkaline earth metal base is incorporated through the hydroxyl group of the salicylate". In example 4 of Campbell, it describes that in the preparation of overbased alkyl methyl salicylate "proton nuclear magnetic resonance spectroscopy (H-nmr) and infrared spectroscopy of the resulting composition indicated the retention of the methyl ester in the overbased product." (column 9, line 33-36). Thus, Campbell does not disclose that which is claimed in the present invention, because Campbell does not disclose a salicylate which is a salt of a carboxyl group of alkyl salicylic acid and an alkaline (alkaline earth) metal.

Moreover, unlike the present invention where the position of the alkyl substituent of the salicylate is claimed as 3- and 5- disubstituted, Campbell does not disclose the position of the alkyl substituent of the salicylate.

Therefore, the structure of the salicylate of the present invention is not obvious with respect to the structure disclosed in Campbell.

Furthermore, the present invention is not obvious to the cited reference Carrick, which discloses a "salicylate detergent", explained as "typical salicylate

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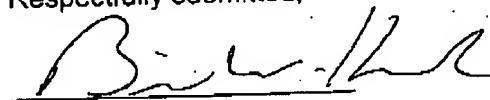
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detergents are metal over-based salicylates having a sufficiently long hydrocarbon substituent to promote oil solubility." This implies the salicylate is mono-alkylsubstituted which is different from the salicylate of our invention. Additionally, no information about the carbon number of the alkyl substituent and the position of the substituent is disclosed in Carrick. Furthermore, the other compounds disclosed in Carrick are different than the compound claimed in the present invention. The salixalate is a compound obtained by a reaction of polyisobutetyl substituted phenol, formaldehyde, and salicylic acid (paragraph 0068-0069). The saligenin is metal salt of salicylalcohol which does not possess a carboxyl group. Therefore, the present invention is not obvious with respect to Carrick because the salicylate of the present invention is different than that disclosed in Carrick.

In the Office Action, Claims 2 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carrick in view of Chambard (U.S. Pub. No. 2002/0082176). With respect to the reference Chambard, the Applicant believes Claims 2 and 4 are not obvious to Carrick and Chambard for the discussion of Carrick above. The salicylate claimed in the present invention is different than the one disclosed in Carrick.

In light of the foregoing response, all the outstanding rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,



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Date

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